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REQUEST FOR ORAL HEARING BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional)  PGR-100	
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		Application Number <u>09/759,423</u>	Filed <u>January 12, 2001</u>
		For Method and Apparatus for Trailer Jack Mount	
		Art Unit <u>3723</u>	Examiner <u>Robert C. Watson</u>
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The fee for this Request for Oral Hearing is (37 CFR 41.20(b)(3))		\$ <u>1000.00</u>	
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:		\$ <u>500.00</u>	
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<input type="checkbox"/> applicant/inventor.		<u>James S. Parker</u> Typed or printed name	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		<u>November 28, 2005</u> Date	
<input checked="" type="checkbox"/> attorney or agent of record Registration number <u>40,119</u>		<u>352-375-8100</u> Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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EXAMINER: Robert C. Watson

FROM: James S. Parker

COMPANY: U.S. Patent Office

DATE: November 28, 2005

FAX NO.: (571) 273-8300

NO. OF PAGES  
(INCLUDING COVER SHEET): 10

SUBJECT/MESSAGE:

Re: Serial No. 09/759,423; filed January 12, 2001  
Attorney Docket No. PGR-100

1. Request for Oral Hearing (1 page)
2. Reply to Examiner's Answer Under 37 CFR §41.41 (8 pages)

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REPLY BRIEF  
Examining Group 3723  
Patent Application  
Docket No. PGR-100  
Serial No. 09/759,423

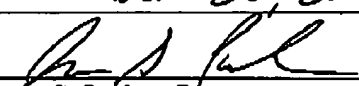
## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner : Robert C. Watson  
Art Unit : 3723  
Appellant : E. Paul Green  
Serial No. : 09/759,423  
Filed : Method and Apparatus for Trailer Jack Mount

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REPLY TO EXAMINER'S ANSWER UNDER 37 CFR §41.41

I hereby certify that this correspondence is being  
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November 28, 2005  
  
James S. Parker, Patent Attorney

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**I. STATUS OF CLAIMS**

The Examiner asserts that the statement of the status of claims contained in the brief is not correct. Although appellant misstates the status of claims 23-37 in the Appendix at page 22 of the brief, Appellant respectfully asserts that the Brief does contain the correct statement of the status of claims at page 1, section III of the Brief. For purposes of clarity, Appellants hereby state that Claims 23-37 were withdrawn in the Amendment dated September 22, 2003.

**II. ARGUMENT****A. The specification provides sufficient written description of an A-frame coupler designed to couple to a hitch ball, as claimed in claims 39-41.**

Claims 39-41 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

In reference to the 112 rejection, the Examiner asserts that the Examiner does not see any 'hitch ball' or 'ball socket' in Figure 1A. However, examination of Figure 1A clearly indicates a ball socket incorporated with the A-frame coupler. This ball socket incorporated with the A-frame coupler shown in Figure 1A is for connection to a hitch ball. Therefore an A-frame coupler designed to couple to a hitch ball is clearly shown. Accordingly, the recitation in claims 39-41 that "the A-frame coupler is designed to couple to a hitch ball", and the reference to "a ball socket" is not new matter. In addition, one skilled in the art, at the time the application was filed, having access to the application, would have understood that the appellant was in possession of the subject invention as claimed in claims 39-41.

Accordingly, the appellant respectfully requests the rejection of claims 39-41 under 35 U.S.C. §112, first paragraph, be reversed.

**B. Claim 1 is not rendered obvious by the cited references.**

The Examiner maintains that claims 1-2, 21-22, and 38-40 are rejected under 35 USC §103(a) as being unpatentable over Sweetland (U.S. Patent No. 3,345,037) in view of Linton *et al.* (U.S. Patent No. 4,176,824).

The Examiner's Answer, at page 4, states that "Sweetland shows a jack coupled to an A-frame coupler of a trailer". The appellant asserts that the Sweetland reference teaches, at col. 2, lines 33-47, "[i]n the embodiment ... the support device is attached at the forward end of the yoke A of a trailer ... a top plate 18 and a bottom plate 19 are mounted over the two legs 20 and 21 forming yoke A ... [s]upporting device 8 is adapted for removable nesting within the two keyways". Accordingly, the top plate 18 and bottom plate 19 are part of the Sweetland support device.

In the Examiner's Answer, the Examiner has changed his position regarding the primary purpose of the Sweetland reference. Throughout prosecution, the Examiner has maintained that the primary purpose of the jack taught by the Sweetland reference is for raising the vehicle. In the Examiner's first categorization of the primary purpose of the jack taught by the Sweetland reference, the Examiner stated, at page 2 of the Advisory Action dated February 4, 2004, that "[a] jack that is either removable or not removable does not defeat Sweetland's principle purpose of lifting a trailer A-frame." This argument was repeated, at page 4 of the Office Action dated March 24, 2004 and at page 5 of the Office Action dated November 10, 2004, where the Examiner stated that "the primary purpose of the jack in Sweetland is for raising the vehicle so the purpose of the jack in Sweetland indeed has not been defeated by the Linton *et al.* modification."

Now, at page 4, first paragraph of the Examiner's Answer, the Examiner asserts that "the jack is removable from the trailer for the sole purpose of stowing the jack in a remote location". On page 6 of the Examiner's Answer, the Examiner states that "the principal object of the Sweetland invention is the stowability of the Sweetland jack and not the removability of the Sweetland jack. The Examiner seems to rest this new position on his belief that the only reason to remove the jack is to stow the jack. The last sentence on page 6 of the Examiner's Answer states "there is absolutely no reason for the removability of the Sweetland jack other than to stow the jack remotely so that the jack is out of the way when the trailer moves along the ground". On page 7 of the Examiner's Answer, the Examiner makes additional statements that "the 'removability' of the Sweetland jack has no end in and of itself since the Sweetland jack is not disclosed as having any fractional use when the jack is removed from the Sweetland trailer" and "[q]uite simply, the removed Sweetland jack is stowed somewhere and is never used until it is reconnected to the trailer at some subsequent time when the jack is again needed to raise the

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trailer". The appellant strongly disagrees with this new position, and in particular, strongly disagrees with the view that there is absolutely no reason for the removability of the Sweetland jack other than to stow the jack remotely. When the Sweetland jack is removed, the jack can be used with other A-frame trailers. Accordingly, using the ability to use the Sweetland jack with another A-frame trailer is at least one additional reason for the removability of the Sweetland jack. At column 1, line 24, Sweetland teaches "in trailers, such as, house trailers, boat trailers, and the like". When working with, for example, house trailers, once the house trailer is positioned where the house trailer is to be located, the user can use the Sweetland jack to raise the yoke of the house trailer off of the vehicle such that the jack supports the weight of the yoke. The house trailer can then be leveled and the yoke positioned on, for example, concrete blocks and the Sweetland jack can then be removed. This removed jack can then be used with another house trailer in a similar fashion. Such a procedure could allow a jack to be kept with, for example, the towing vehicle. However, the Sweetland jack cannot be used with another house trailer without being removed from the first house trailer. In this way, fewer jacks would be needed, saving costs rather than having one jack for each house trailer. Further, as the house trailer may not need to be moved for a substantial period of time, removal of the Sweetland jack can reduce the cluttered look the house trailer may have with a Sweetland jack attached to the yoke of the house trailer and removal of the Sweetland jack may extend the life of the Sweetland jack by reducing the amount of exposure to the weather the Sweetland jack experiences.

In light of the above-referenced potential reasons for removability of the Sweetland jack and additional uses for the removed Sweetland jack, we can see the falseness of the position that "there is absolutely no reason for the removability of the Sweetland jack other than to stow the jack remotely so that the jack is out of the way when the trailer moves along the ground"; "the 'removability' of the Sweetland jack has no end in and of itself since the Sweetland jack is not disclosed as having any fractional use when the jack is removed from the Sweetland trailer" and "[q]uite simply, the removed Sweetland jack is stowed somewhere and is never used until it is reconnected to the trailer at some subsequent time when the jack is again needed to raise the trailer".

Furthermore, the title of the Sweetland patent is "REMOVABLE TRAILER SUPPORT"; the abstract teaches "a device for attachment of the yoke of a trailer in which a vertical element can be removably attached ... "; the first sentence of the description (col. 1, lines 21-23) states

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"this invention relates to a removable support for ... "; the Sweetland reference, at col. 1, lines 37-39, states "it is the principal object of this invention to provide a support removably engageable with the yoke of a trailer ..."; and the Sweetland reference only refers to the removability of the Sweetland jack.

Accordingly, the appellant vigorously asserts the intended purpose of the device taught by the Sweetland reference is a removable trailer support.

"If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification". *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Therefore, there is no suggestion or motivation to make the modification proposed in the Office Action.

In addition, "if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious". *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Referring to page 4, first full paragraph, of the Green Declaration, Mr. Green states

"the modification proposed in the Office Action would change the principle of operation of the Sweetland device, namely to be a support removably engageable with the yoke of a trailer (column 1, line 37-39) with respect to which the Sweetland reference teaches "[i]n operation, yoke A is held at an elevation wherein the shaft 30, in the areas above bushing 39 and 40, can fit through mouths 43 and 44 into keyways 25 and 26; in the aforesaid position, shaft 30 is maintained in vertical alignment ... [y]oke A is then lowered wherein plate 13 at the area adjacent keyway 25 rests upon flange 38 to support the yoke" (see column 2, lines 66-72)."

Therefore, the teachings of the Sweetland and Linton *et al.* references are not sufficient to render the rejected claims *prima facie* obvious.

Accordingly, one of ordinary skill in the art would not have been motivated to employ on the Sweetland vehicle A-frame coupler a first piece mounted to the vehicle and a second piece mounted to the vehicle jack in order to enable the A-frame mounted jack of Sweetland to be able

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to transition between a plurality of vertical positions such that the jack will be initially positioned at a correct vertical position relative to the ground before jacking is begun. A *prima facie* case of obviousness has not been presented with respect to claims 1-2, 21-22, and 38-40. Therefore, the appellant respectfully requests reconsideration and withdrawal of the rejection of claims 1-2, 21-22, and 38-40 under 35 U.S.C. §103(a).

**D. Claim 3 is not rendered obvious by the cited references.**

Claims 3-12 and 41 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sweetland in view of Linton *et al.* taken with Ebey (U.S. Patent No. 4,623,125). Appellant's arguments regarding claims 1 and 2 are incorporated herein by reference in their entirety. Further, claim 3 adds the limitation wherein said first piece is pivotally connected to said second piece. The Examiner's Answer, at page 5, states "[t]o provide additional mating holes in the first or second mounting pieces of Sweetland in view of Linton *et al.* supra so as to enable the vehicle jack to be pivoted between a vertical use position and a horizontal stowed position would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Ebey." However, the Examiner's Answer has not described where mating holes in the first or second mounting pieces of the Linton *et al.* device could be positioned to allow the vehicle jack to pivot. Furthermore, bails 40 would appear to prevent any such pivoting. The Examiner's Answer, at page 5-6, also states "one of ordinary skill in the art would have been motivated to do this in order to enable the jack to be conveniently pivoted from use to a horizontal stored position". The appellant does not agree that one of ordinary skill in the art would have been motivated to modify mounting pieces of Sweetland in view of Linton *et al.* so as to enable the vehicle jack to be pivoted between a vertical use position and a horizontal stowed position in view of the disclosure of Ebey. There would be no motivation as the Linton type device can already be transitioned between a stowed position and a use position. Furthermore, if one were to try to pivot the Sweetland jack to a horizontal position, the Sweetland jack would hit legs 20 and 21 and, therefore, could not reach the horizontal position. The appellant suspects this is why the Ebey reference teaches mounting the Ebey device to the tongue of a trailer (see abstract), as the Ebey device requires room to allow the jack to rotate to and from the horizontal position. In contrast, if one were to try and rotate the Sweetland jack as shown in Ebey, the Sweetland jack would not be able to rotate as legs 20 and 21 are in the way.

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Page 8, first full paragraph, of the Examiner's Answer states, "Claim 1 is merely claiming a first piece and a second piece, whereby the first and second pieces can transition between a plurality of positions". This is not true. Claim 1 includes the limitations "a first piece mountable to an A-frame coupler of a trailer" and "a second piece mountable to a trailer jack". In this way, "mountable to an A-frame coupler of a trailer" limits the structure of "a first piece" and "mountable to a trailer jack" limits the structure of a "a second piece". Claims 4 and 41 include the limitation "said first piece comprises a trailer mounting structure for mounting to the A-frame coupler of the trailer and at least one extending structure for pivotally connecting to said second piece ... wherein said second piece comprises a trailer jack mounting structure for mounting to the trailer jack and at least one pivoting arm for pivotally connecting to said first piece, wherein said at least one extending structure and said at least one pivoting arm are pivotally connected to each other by a pivoting means". The Examiner has not shown any of these features in the Sweetland, Linton, or Ebey references. In particular, the Examiner has not shown how the Sweetland, Linton, and Ebey references can be combined to include these limitation and have the jack rotate without the jack hitting the legs 20 and 21 of the Sweetland A-frame trailer.

Appellant respectfully submits that this rejection fails to raise a *prima facie* case of obviousness for the claimed invention because the cited references, alone or in combination, do not disclose or suggest the unique and advantageous method and apparatus for trailer jack mount claimed herein. It is also respectfully submitted that the combination of references fails to meet a variety of limitations set forth in the claims and that the rejection is the result of improper hindsight reconstruction of the claimed invention.

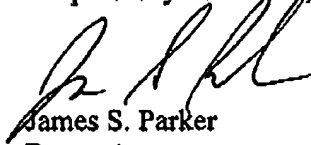
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Docket No. PGR-100

Serial No. 09/759,423

In view of the foregoing, appellant urges that the Board reverse the 35 USC §112, first paragraph rejection, and the 35 USC §103(a) obviousness rejections and that this application be passed to issuance.

Respectfully submitted,



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Attachment: Request For Oral Hearing

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